



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,339	08/28/2003	Martin Novil	03-0019	6840

29293 7590 03/02/2006

FREUDENBERG-NOK GENERAL PARTNERSHIP  
LEGAL DEPARTMENT  
47690 EAST ANCHOR COURT  
PLYMOUTH, MI 48170-2455

EXAMINER

PATEL, VISHAL A

ART UNIT	PAPER NUMBER
----------	--------------

3673

DATE MAILED: 03/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/650,339	<b>Applicant(s)</b> NOVIL ET AL.	
	<b>Examiner</b> Vishal Patel	<b>Art Unit</b> 3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-73 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br/>Paper No(s)/Mail Date <u>12/15/05</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 12/15/05 has been entered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8, 11-24, 26-37, 39-51, 53-65, 67-68 and 69-73 are rejected under 35 U.S.C. 102(e) as being anticipated by Okazaki et al (US. 6,550,782).

Okazaki discloses a gasket having a relatively rigid carrier (1) having first and second laterally extending sides defining a longitudinal thickness (thickness of 1), the carrier having at least one gasket opening (opening 2) there through, a resilient sealing material (7-8 and 17-18) substantially more flexible than the carrier and being disposed on at least portions of the laterally extending sides of the carrier (7-8 and 17-18 extend on laterally sides of the gasket), a longitudinally flexible inner sealing portion (inner portion adjacent to the opening 2 and having the resilient sealing material 8 and 18) that is substantially defining the periphery of the gasket

Art Unit: 3673

opening, the inner sealing portion being longitudinally offset relative to the remainder of the carrier (this is the case since the bead 6 offsets the inner portion relative to the carrier), the inner sealing portion being offset in a longitudinal direction (offset by the bead 6), the inner sealing portion having the resilient sealing material disposed on at least portions of its laterally extending sides, a longitudinally flexible outer stopper portion (5) of the carrier spaced laterally away from the gasket opening and disposed laterally outward relative to the inner sealing portion, the flexible outer stopper portion and the inner sealing portion being in close proximity with each other and in close lateral proximity with the same the gasket opening (the opening, the inner sealing portion and the stopper are in close lateral proximity), the flexible stopper being convex on one side and concave on the opposite side of the one side (the stopper 5 has a convex portion at top of 1 and concave at bottom of 1) and the flexible stopper being less flexible than the inner sealing portion (that is the case since one is a half bead and the other is a full bead 5) to limit the amount of longitudinal compression of the inner sealing portion (this is the case because as one point the inner sealing portion will contact mating surfaces and at another point the mating surfaces would contact both the inner sealing portion and the stopper).

The inner sealing portion is longitudinally offset to an extent greater than the extend of the longitudinal convexity of the flexible stopper portion (height of the inner sealing portion is greater than the bead height from a flat portion of the carrier between the inner sealing portion and the flexible stopper).

The inner sealing portion has a lateral dimension greater than the lateral dimension of the flexible stopper (the inner sealing portion is larger than the stopper).

The flexible stopper has the resilient sealing material (17) disposed within and at least partially filling its concave side.

The flexible stopper has the resilient sealing material disposed on at least portions of its laterally extending sides (7 and 17).

The flexible stopper member has an additional amount (amount of coating 7 and 17) of the resilient sealing material disposed within and at least partially filling the concave side.

The rigid carrier is a single layer carrier and is metallic.

The resilient sealing material is a rubber containing material, elastomer containing material and covers substantially all of the laterally extending sides of the carrier (column 5, lines 4-5).

The resilient sealing material is adjacent at least portions of the carrier.

Regarding the limitation "screen-printed", this is a process limitation and is given little patentable weight in an apparatus claim.

Regarding limitation to intended use: The gasket is capable of being used in an environment as claimed by applicant (between cylinder head and cylinder block or gaseous fluid conveying device or pipe flanges or manifold flanges or an interior enclosure and an exterior enclosure or mating surfaces of members or intermittently mated surfaces of members).

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okazaki in view of Abe et al (US. 6,070,882).

Okazaki discloses the invention substantially as claimed above but fails to disclose that the carrier is formed of steel or synthetic material. Abe discloses that a metal gasket is made of either steel or synthetic material (column 5, lines 35-40). It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the carrier to be made of either steel or synthetic material as taught by Abe, since having a carrier plate be made of metal or steel or synthetic material is considered to be art equivalent. Furthermore choosing a material due to the environment that is seal by the material is well know to one skilled in the art.

6. Claims 25, 38, 52 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okazaki in view of Stritzke (US. 5,267,740).

Okazaki discloses the invention substantially as claimed above but fails to disclose that the carrier is formed into portions and adjacent portions are bridged by the resilient sealing material. Stritzke discloses a gasket having a metal plate having resilient sealing material (material having beads 52 and 54, figures 7-8), the resilient sealing material is placed on the metal plate and a bridging member is placed between adjacent portion of metal portions of the plate. It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the carrier of Okazaki into portion and connect the portions by bridges that are formed by the resilient sealing material as taught by Stritzke, to prevent inadvertent loss of the sealing aids (column 3, lines 62-65 of Stritzke).

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Miyaoh, Hohe et al, Ii and Uemura et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia L. Engle can be reached on 571-272-6660. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP  
February 22, 2006

A handwritten signature in black ink, appearing to read 'Vishal Patel', with a stylized flourish at the end.

Vishal Patel  
Patent Examiner  
Tech. Center 3600